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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/804,953

Filing Date: March 19, 2004

Appellant(s): BLANK ET AL.

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GROUP 1700

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Francis L. Conte  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed March 19, 2007 appealing from the Office action mailed December 8, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

2,170,147	LANE	8-1939
4,884,826	SLAGSVOL	12-1989
5,578,352	SMITH	11-1996

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 – 9, 11 – 15, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (USPN 5,578,352) in view of Slagsvol (USPN 4,884,826).

Smith discloses a label roll (Column 1, lines 40 – 43) comprising web (Column 2, lines 54 – 58) that is continuous along said running axis and imperforate (Column 3, lines 6 and 7) having a front surface and an opposite back surface wound longitudinally along a running axis (Figure 2, #13 and 14) in a roll (Column 1, lines 40 – 43), said back surface including a plurality of non continuous adhesive patches (Column 3, line 60 to Column 4, line 1; Column 3, lines 42 – 46) aligned in a column along a running axis of said web in a minor area of said back surface with the remaining area of said back surface being devoid of adhesive (Figure 2, #34 and 35; Column 4, lines 16 – 18) and including adhesive-free spaces transversely bridging said web longitudinally between said adhesive patches to isolate said patches in sequential labels and permit cutting of said web in said adhesive-free spaces to separate said labels (Column 3, line 60 to Column 4, line 1; Column 3, lines 42 – 46, whereby the adhesive-free areas are formed in between the discontinuous strips) and said front surface including a release strip extending along said running axis behind said column of adhesive patches and laminated to said patches in successive layers in said roll (Column 3, lines 42 – 52) with said patches being sized for bonding an individual label to a surface (Figure 3, #11) in claims 1 and 3. With regard to claims 4 – 7, the patches are aligned along said and edge of said web (Figure 2, #34 and 35), have

straight edges aligned parallel and transversely with said running axis forming a rectangular shaped area (Figure 3) and are elongate along said running axis (Figure 2 and 3). The web further includes corresponding index marks between adjacent patches to define corresponding labels (Figure 3, #19) as in claims 8 and 15. With regard to claims 17 and 18, the release strip is narrow to conform in width with said column of adhesive patches thereby leaving the remainder of the web front side devoid (Column 3, lines 48 – 42) and is made from a silicone coating (Column 3, line 33). However, Smith fails to disclose the patches being isolated on one side only of the transverse middle, being aligned on one lateral edge of the web and closer thereto than an opposite edge of said web, the patches have arcuate edges extending transversely with said running axis, convex leading edges with convex trailing edges connected by straight edges, ovals with major axes disposed parallel to the running axis, and the patches being elongate transverse to said running axis.

Slagsvol teach disclose the patches being isolated on one side only of the transverse middle (Figure 6, #2f; Column 2, lines 45 – 48), being aligned on one lateral edge of the web and closer thereto than an opposite edge of said web (Figure 6, #2f; Column 2, lines 45 – 48) for the purpose of forming a paper that is easily and rapidly applied to a surface (Column 1, lines 43 – 44).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a single adhesive patch isolated on one side only of the

transverse middle in Smith in order to form a paper that is easily and rapidly applied to a surface as taught by Slagsvol.

Regarding the patches having arcuate edges extending transversely with said running axis, convex leading edges with convex trailing edges connected by straight edges, ovals with major axes disposed parallel to the running axis, it is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947), *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape, which would have been unforeseen to one of ordinary skill in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the adhesive patch as Smith teaches a variety of shapes being used (Column 3, line 60 to Column 4, line 1; Column 3, lines 42 – 46).

Claims 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (USPN 5,578,352) in view of Slagsvol (USPN 4,884,826) and Lane (USPN 2,170,147).

Smith, as modified with Slagsvol, discloses the claimed roll except for the web being devoid of index marks and the release strip covering said web front side in full.

Lane teaches the patches of adhesive (Figure 1, #11; Page 2, Column 1, lines 33 – 38), the release strip covering said web front in full (Page 2, Column 1, lines 44 – 51) and devoid of index marks (Figure 1) for the purpose of being able to cut each band from a coated sheet without gumming the cutting knife and with fusing together the edges of the resulting bands (Page 3, Column 1, lines 15 – 20).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a single adhesive patch in an elongate shape in the modified Smith in order to cut each band from a coated sheet without gumming the cutting knife and with fusing together the edges of the resulting bands as taught by Lane since the modified Smith discloses the use of discontinuous strips (Column 3, line 60 to Column 4, line 1; Column 3, lines 42 – 46).

Claims 19 – 25, 27 – 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (USPN 5,578,352) in view of Slagsvol (USPN 4,884,826).

Smith discloses a label roll (Column 1, lines 40 – 43) comprising web (Column 2, lines 54 – 58) that is continuous along said running axis and imperforate (Column 3, lines 6 and 7) having a front surface and an opposite back surface wound longitudinally along a running axis (Figure 2, #13 and 14) in a roll (Column 1, lines 40 – 43), said back surface including a plurality of non continuous adhesive patches (Column 3, line 60 to Column 4, line 1; Column 3, lines 42 – 46) aligned in a column along a running axis of said web in a minor area of said back surface

with the remaining area of said back surface being devoid of adhesive (Figure 2, #34 and 35; Column 4, lines 16 – 18) and including adhesive-free spaces transversely bridging said web longitudinally between said adhesive patches to isolate said patches in sequential labels and permit cutting of said web in said adhesive-free spaces to separate said labels (Column 3, line 60 to Column 4, line 1; Column 3, lines 42 – 46, whereby the adhesive-free areas are formed in between the discontinuous strips) and said front surface including a release strip extending along said running axis behind said column of adhesive patches and laminated to said patches in successive layers in said roll (Column 3, lines 42 – 52) with said patches being sized for bonding an individual label to a surface (Figure 3, #11) in claims 19 and 31. With regard to claims 23 and 24, the patches are aligned along said and edge of said web (Figure 2, #34 and 35), have straight edges aligned parallel and transversely with said running axis forming a rectangular shaped area (Figure 3) and are elongate along said running axis (Figure 2 and 3). The web further includes corresponding index marks between adjacent patches to define corresponding labels (Figure 3, #19) as in claims 21 and 25. With regard to claims 22 and 29, the release strip is narrow to conform in width with said column of adhesive patches thereby leaving the remainder of the web front side devoid (Column 3, lines 48 – 42) and is made from a silicone coating (Column 3, line 33). As in claim 28, each of said labels has a plurality of said adhesive patches (Figure 2, #34 and 35). However, Smith fails to disclose the patches being isolated on one side only of the transverse middle, being aligned on one lateral edge of the web and closer thereto than an opposite edge of said web, the patches have arcuate edges extending transversely with said running axis, convex leading edges with convex trailing edges connected by straight

edges, ovals with major axes disposed parallel to the running axis, and the patches being elongate transverse to said running axis.

Slagsvol teach disclose the patches being isolated on one side only of the transverse middle (Figure 6, #2f; Column 2, lines 45 – 48), being aligned on one lateral edge of the web and closer thereto than an opposite edge of said web (Figure 6, #2f; Column 2, lines 45 – 48) for the purpose of forming a paper that is easily and rapidly applied to a surface (Column 1, lines 43 – 44).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a single adhesive patch isolated on one side only of the transverse middle in Smith in order to form a paper that is easily and rapidly applied to a surface as taught by Slagsvol.

Regarding the patches having arcuate edges extending transversely with said running axis, convex leading edges with convex trailing edges connected by straight edges, ovals with major axes disposed parallel to the running axis, it is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947), *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape, which would have been unforeseen to one of ordinary skill in the art. Therefore, it

would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the adhesive patch as Smith teaches a variety of shapes being used (Column 3, line 60 to Column 4, line 1; Column 3, lines 42 – 46).

With regard to the limitations of “for use in a printer having a cutting blade” and “permit transverse cutting of said web said blade” in claim 19, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The language of the claim is directed towards the structure of the label roll and not how the label roll is being used in combination with the printer or the cutting blade.

With regard to the limitations of “said printer includes an index sensor ” and “datable by said sensor” in claim 25, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The language of the claim is directed towards the structure of the label roll and not how the label roll is being used in combination with the printer that includes a index sensor.

**(10) Response to Argument**

**Ground 1**

**Nonanalogous Art**

Appellants argue that Slagsvol is nonanalogous art relation neither to Appellants' field of endeavor or specific problems. Appellants also argue that the tracing paper in Slagsvol is tracing paper and is not characterized or used as any label relevant to the industry. Appellants further argue that the Examiner fails to present a *prima facie* case of obviousness for Slagsvol as there are no labels in Slagsvol.

In response to Appellants argument that Slagsvol is nonanalogous art relation neither to Appellants' field of endeavor or specific problems, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, a label, as defined by [www.webster.com](http://www.webster.com), is "a slip (as of paper or cloth) inscribed and affixed to something for identification or description". A label, as defined by [www.dictionary.com](http://www.dictionary.com), is "a slip of paper, cloth, or other material, marked or inscribed, for attachment to something to indicate its manufacturer, nature, ownership, destination, etc". Slagsvol becomes a label the moment a mark is made on the surface of tracing paper and the paper is stuck to the surface of an object and a mark is made on the surface of the binding strip and the paper is adhered to the surface of an object, respectively. Therefore, Slagsvol is not considered non-analogous art based on the definition of a label as they are pertinent to the

particular problem with which the applicant was concerned, the placement of adhesive on the pack surface of a web.

In response to Appellants argument that the tracing paper in Slagsvol is tracing paper and is not characterized or used as any label relevant to the industry, as defined by [www.webster.com](http://www.webster.com), is “a slip (as of paper or cloth) inscribed and affixed to something for identification or description”. A label, as defined by [www.dictionary.com](http://www.dictionary.com), is “a slip of paper, cloth, or other material, marked or inscribed, for attachment to something to indicate its manufacturer, nature, ownership, destination, etc”. Slagsvol becomes a label the moment a mark is made on the surface of tracing paper and the paper is stuck to the surface of an object and a mark is made on the surface of the binding strip and the paper is adhered to the surface of an object, respectively.

In response to Appellants argument that the Examiner fails to present a *prima facie* case of obviousness for Slagsvol as there are no labels in Slagsvol, a label, as defined by [www.webster.com](http://www.webster.com), is “a slip (as of paper or cloth) inscribed and affixed to something for identification or description”. Michel becomes a label the moment a mark is made on the surface of the binding strip and the paper is adhered to the surface of an object, respectively. Therefore, Michel is not considered non-analogous art based on the definition of a label.

**Claims 1 and 19**

Appellants argue that Smith appears to teach away from claims 1 and 19 which expressly recites different length adhesive-free zones in each label, whereas Smith would clearly teach uniform or equal length patterns of adhesive and silicone for uniform and sufficient bond strength in the label. Appellants further argue that the Examiner fails to present a *prima facie* case of obviousness for Smith in view of Slagsvol as there are no labels in Slagsvol. Appellant argue that the Examiner is using hindsight to combine the references to construct the Appellant's invention.

In response to Appellants argument that Smith appears to teach away from claim 1 which expressly recites different length adhesive-free zones in each label, whereas Smith would clearly teach uniform or equal length patterns of adhesive and silicone for uniform and sufficient bond strength in the label, Smith clearly states that the adhesive may have patterns or be applied in a continuous strip (Column 3, line 66 to Column 4, line 6). The pattern of adhesive varies as it does for the silicone patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). The shapes of the adhesive is described using the same description of the silicone patterns in the specification of the prior art of Smith as shown by the statement "Also, while continuous strips 34, 35 are desired, other patterns can be applied in the same as indicated for the silicone patterns 27, 28". Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern, which would result in a change of length of the adhesive free zones in the label.

In response to Appellants argument that the Examiner fails to present a *prima facie* case of obviousness for the combination of Smith and Slagsvol as there are no labels in Slagsvol, a label, as defined by [www.webster.com](http://www.webster.com), is “a slip (as of paper or cloth) inscribed and affixed to something for identification or description”. Slagsvol becomes a label the moment a mark is made on the surface of the binding strip and the paper is adhered to the surface of an object, respectively. Therefore, Slagsvol is not considered non-analogous art based on the definition of a label. As for the Examiner failing to explain how to modify the label roll in Smith, Smith discloses that it is known to have adhesive in the form of discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46) in a roll. It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have a label with different adhesive shapes as taught by the combination of Slagsvol and Smith.

In response to Appellants argument that the Examiner is using hindsight to combine the references to construct the Appellant's invention, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). A label, as defined by [www.webster.com](http://www.webster.com), is “a slip (as of paper or cloth) inscribed and affixed to something for identification or description”. Smith and Slagsvol all teach that it is known to use a variety of shapes of adhesive in combination with a web to form a label.

**Claims 2 and 19**

Appellants argue that the combination of Smith and Slagsvol fail to disclose the column of patches aligned closer to one edge than the other. Appellants further argue that the Examiner has used hindsight without regard to reason.

In response to Appellants argument that the combination of Smith and Slagsvol fail to disclose the column of patches aligned closer to one edge than the other, Slagsvol teaches that it is known to have adhesive patches on both edges of a substrate (Figure 5) or just on a single side (Figure 6). Therefore, it would have been obvious to one of ordinary skill in the art to place an adhesive only on one side of the substrate for the purpose of controlling the adherence of the substrate to a surface.

In response to Appellants argument that the Examiner is using hindsight to combine the references to construct the Appellant's invention, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). A label, as defined by [www.webster.com](http://www.webster.com), is "a slip (as of paper or cloth) inscribed and affixed to something for identification or description". Slagsvol teaches that it is known to use adhesive on one side of the web to form a label.

**Claims 3 and 19**

Appellants argue that Slagsvol and Smith both fail to disclose the imperforate web.

In response to Appellants argument that Slagsvol and Smith both fail to disclose the imperforate web, Smith discloses a label roll (Column 1, lines 40 – 43) comprising web (Column 2, lines 54 – 58) that is continuous along said running axis and imperforate (Column 3, lines 6 and 7).

**Claim 4**

Appellants argue that Smith fails to disclose the straight edges parallel to the running axis in the specification for specific benefit.

In response to Appellants argument that Smith fails to disclose the straight edges parallel to the running axis in the specification for specific benefit, Smith clearly states that the adhesive may have patterns or be applied in a continuous strip (Column 3, line 66 to Column 4, line 6). The pattern of adhesive varies as it does for the silicone patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). The shapes of the adhesive is described using the same description of the silicone patterns in the specification of the prior art of Smith as shown by the statement “Also, while continuous strips 34, 35 are desired, other patterns can be applied in the same as indicated for the silicone patterns 27, 28”. Therefore, it would have been obvious to one of ordinary skill in the

art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the patches.

**Claim 5**

Appellants argue that Smith fails to disclose the transverse straight edges of the patches and correspondingly disclosed in the specification benefit.

In response to Appellants argument that Smith fails to disclose the transverse straight edges of the patches and correspondingly disclosed in the specification benefit, Smith clearly states that the adhesive may have patterns or be applied in a continuous strip (Column 3, line 66 to Column 4, line 6). The pattern of adhesive varies as it does for the silicone patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). The shapes of the adhesive is described using the same description of the silicone patterns in the specification of the prior art of Smith as shown by the statement “Also, while continuous strips 34, 35 are desired, other patterns can be applied in the same as indicated for the silicone patterns 27, 28”. Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the patches.

**Claim 6**

Appellants argue that Smith fails to disclose the rectangular patches and correspondingly disclosed in the specification benefit.

In response to Appellants argument that Smith fails to disclose the rectangular patches and correspondingly disclosed in the specification benefit, Smith clearly states that the adhesive may have patterns or be applied in a continuous strip (Column 3, line 66 to Column 4, line 6). The pattern of adhesive varies as it does for the silicone patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). The shapes of the adhesive is described using the same description of the silicone patterns in the specification of the prior art of Smith as shown by the statement “Also, while continuous strips 34, 35 are desired, other patterns can be applied in the same as indicated for the silicone patterns 27, 28”. Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the patches.

### Claim 7

Appellants argue that Smith fails to disclose the elongate patches along the running axis.

In response to Appellants argument that Smith fails to disclose the elongate patches along the running axis, Smith clearly states that the adhesive may have patterns or be applied in a continuous strip (Column 3, line 66 to Column 4, line 6). The pattern of adhesive varies as it does for the silicone patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). The shapes of the adhesive is described using the same description of the silicone patterns in the specification of the prior art of Smith as shown by the statement “Also, while continuous strips 34, 35 are

desired, other patterns can be applied in the same as indicated for the silicone patterns 27, 28".

Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the patches.

### **Claims 8 and 15**

Appellants further argue that Smith fails to disclose cooperation between the registration marks and the adhesive free zones.

In response to Appellants argument that that Smith fails to disclose cooperation between the registration marks and the adhesive free zones, the claims state that web has a series of index marks spaced longitudinally there along to define a series of labels. The language of the claim states nothing with regard to the adhesive free zones and the index marks cooperating together as the claim does not give a specific placement of the index marks in correlation to the adhesive free zones.

### **Claim 9**

Appellants argue that Smith fails to disclose the elongate transverse patches along the running axis.

In response to Appellants argument that Smith fails to disclose the elongate transverse patches along the running axis, Smith clearly states that the adhesive may have patterns or be applied in a continuous strip (Column 3, line 66 to Column 4, line 6). The pattern of adhesive

varies as it does for the silicone patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). The shapes of the adhesive is described using the same description of the silicone patterns in the specification of the prior art of Smith as shown by the statement “Also, while continuous strips 34, 35 are desired, other patterns can be applied in the same as indicated for the silicone patterns 27, 28”. Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the patches.

### Claim 11

Appellants argue that Smith fails to disclose a plurality of the patches in the label

In response to Appellants argument that Smith fails a plurality of the patches in the label, Smith clearly states that the adhesive may have patterns or be applied in a continuous strip (Column 3, line 66 to Column 4, line 6). The pattern of adhesive varies as it does for the silicone patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have multiple adhesive patches, since it has been held that mere duplication of the essential working parts of an article requires only routine skill in the art. MPEP 2144.04. Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the patches.

**Claim 12**

Appellants argue that Smith fails to disclose the arcuate edge species of the patches.

In response to Appellants argument that Smith fails to disclose the arcuate edge species of the patches, Smith clearly states that the adhesive may have patterns or be applied in a continuous strip (Column 3, line 66 to Column 4, line 6). The pattern of adhesive varies as it does for the silicone patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). The shapes of the adhesive is described using the same description of the silicone patterns in the specification of the prior art of Smith as shown by the statement “Also, while continuous strips 34, 35 are desired, other patterns can be applied in the same as indicated for the silicone patterns 27, 28”. Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the patches.

**Claim 13**

Appellants argue that Smith fails to disclose the convex leading and trailing edge species of the patches.

In response to Appellants argument that Smith fails to disclose the convex leading and trailing edge species of the patches, Smith clearly states that the adhesive may have patterns or be applied in a continuous strip (Column 3, line 66 to Column 4, line 6). The pattern of adhesive varies as it does for the silicone patterns, wherein the patterns are chosen from discontinuous

strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). The shapes of the adhesive is described using the same description of the silicone patterns in the specification of the prior art of Smith as shown by the statement “Also, while continuous strips 34, 35 are desired, other patterns can be applied in the same as indicated for the silicone patterns 27, 28”. Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the patches.

#### Claim 14

Appellants argue that Smith fails to disclose the oval species of the adhesive patches.

In response to Appellants argument that Smith fails to disclose the oval species of the adhesive patches, Smith clearly states that the adhesive may have patterns or be applied in a continuous strip (Column 3, line 66 to Column 4, line 6). The pattern of adhesive varies as it does for the silicone patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). The shapes of the adhesive is described using the same description of the silicone patterns in the specification of the prior art of Smith as shown by the statement “Also, while continuous strips 34, 35 are desired, other patterns can be applied in the same as indicated for the silicone patterns 27, 28”. Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the patches.

**Claim 17**

Appellants argue that Smith fails to disclose the narrow release strip.

In response to Appellants argue that Smith fails to disclose the narrow release strip, Smith clearly states that the silicone has many patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the silicone release strips.

**Claim 18**

Appellants argue that Smith fails to disclose the silicone form of the release strip.

In response to Appellants argue that Smith fails to disclose the silicone form of the release strip, Smith clearly states that the silicone has many patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the silicone release strips.

**Ground 2**

Appellants argue that Slagsvol is nonanalogous art relation neither to Appellants' field of endeavor or specific problems.

In response to Appellants argument that Slagsvol is nonanalogous art relation neither to Appellants' field of endeavor or specific problems, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, a label, as defined by [www.webster.com](http://www.webster.com), is "a slip (as of paper or cloth) inscribed and affixed to something for identification or description". A label, as defined by [www.dictionary.com](http://www.dictionary.com), is "a slip of paper, cloth, or other material, marked or inscribed, for attachment to something to indicate its manufacturer, nature, ownership, destination, etc". Slagsvol becomes a label the moment a mark is made on the surface of tracing paper and the paper is stuck to the surface of an object and a mark is made on the surface of the binding strip and the paper is adhered to the surface of an object, respectively. Therefore, Slagsvol is not considered non-analogous art based on the definition of a label as they are pertinent to the particular problem with which the applicant was concerned, the placement of adhesive on the pack surface of a web.

**Claim 10**

Appellants further argue that Smith fails to disclose cooperation between the registration marks and the adhesive free zones.

In response to Appellants argument that that Smith fails to disclose cooperation between the registration marks and the adhesive free zones, the claims state that web has a series of index marks spaced longitudinally there along to define a series of labels. The language of the claim states nothing with regard to the adhesive free zones and the index marks cooperating together as the claim does not give a specific placement of the index marks in correlation to the adhesive free zones.

**Claim 16**

Appellants argue that the prior art fails to disclose the full surface of the release strip in combination with the columnar adhesive patches.

In response to Appellants argue that the prior art fails to disclose the full surface of the release strip in combination with the columnar adhesive patches, Smith clearly states that the silicone has many patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the silicone release strips.

**Ground 3**

Appellants argue that Slagsvol is nonanalogous art relation neither to Appellants' field of endeavor or specific problems.

In response to Appellants argument that Slagsvol is nonanalogous art relation neither to Appellants' field of endeavor or specific problems, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, a label, as defined by [www.webster.com](http://www.webster.com), is "a slip (as of paper or cloth) inscribed and affixed to something for identification or description". A label, as defined by [www.dictionary.com](http://www.dictionary.com), is "a slip of paper, cloth, or other material, marked or inscribed, for attachment to something to indicate its manufacturer, nature, ownership, destination, etc". Slagsvol becomes a label the moment a mark is made on the surface of tracing paper and the paper is stuck to the surface of an object and a mark is made on the surface of the binding strip and the paper is adhered to the surface of an object, respectively. Therefore, Slagsvol is not considered non-analogous art based on the definition of a label as they are pertinent to the particular problem with which the applicant was concerned, the placement of adhesive on the pack surface of a web.

**Claim 19**

Appellants argue that no weight has been afford to the additional features of the cutting blade and printer in the claim. Appellants further argue that no weight has been given to the single column of noncontiguous adhesive patches. Appellants also argue that the Examiner fails to present a *prima facie* case of obviousness for the combination of Smith and Slagsvol as there are no labels in Slagsvol.

In response to Appellants argument that no weight has been afford to the additional features of the cutting blade and printer in the claim, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The printer is only mentioned in the intended use of the label in claim 19. Therefore, no weight is being given to the limitations of the printer having a feed part and components or the method of using the label roll in combination with a printer. The preamble of the claim is directed towards a linerless label. Slagsvol meets the claim limitations directed towards the label construction in combination with and Smith.

In response to Appellants argument that no weight has been given to the single column of noncontiguous adhesive patch, Slagsvol teaches that it is known to have adhesive patches on both edges of a substrate (Figure 5) or just on a single side (Figure 6). Therefore, it would have

been obvious to one of ordinary skill in the art to place an adhesive only on one side of the substrate for the purpose of controlling the adherence of the substrate to a surface.

In response to Appellants argument that the Examiner fails to present a *prima facie* case of obviousness for the combination of Smith and Slagsvol as there are no labels in Slagsvol, a label, as defined by [www.webster.com](http://www.webster.com), is “a slip (as of paper or cloth) inscribed and affixed to something for identification or description”. Slagsvol becomes a label the moment a mark is made on the surface of the binding strip and the paper is adhered to the surface of an object, respectively. Therefore, Slagsvol is not considered non-analogous art based on the definition of a label. As for the Examiner failing to explain how to modify the label roll in Smith, Smith discloses that it is known to have adhesive in the form of discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46) in a roll. It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have a label with different adhesive shapes as taught by the combination of Slagsvol and Smith.

### **Claim 20**

Appellants argue that Smith fails to disclose the oval species of the adhesive patches.

In response to Appellants argument that Smith fails to disclose the oval species of the adhesive patches, Smith clearly states that the adhesive may have patterns or be applied in a continuous strip (Column 3, line 66 to Column 4, line 6). The pattern of adhesive varies as it does for the silicone patterns, wherein the patterns are chosen from discontinuous strips, dots a

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series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). The shapes of the adhesive is described using the same description of the silicone patterns in the specification of the prior art of Smith as shown by the statement “Also, while continuous strips 34, 35 are desired, other patterns can be applied in the same as indicated for the silicone patterns 27, 28”. Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the patches.

### **Claim 21**

Appellants further argue that Smith fails to disclose cooperation between the registration marks and the adhesive free zones.

In response to Appellants argument that that Smith fails to disclose cooperation between the registration marks and the adhesive free zones, the claims state that web has a series of index marks spaced longitudinally there along to define a series of labels. The language of the claim states nothing with regard to the adhesive free zones and the index marks cooperating together as the claim does not give a specific placement of the index marks in correlation to the adhesive free zones.

### **Claim 22**

Appellants argue that Smith fails to disclose the narrow release strip.

In response to Appellants argue that Smith fails to disclose the narrow release strip, Smith clearly states that the silicone has many patterns, wherein the patterns are chosen from

discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the silicone release strips.

### Claim 23

Appellants argue that Smith fails to disclose the rectangular patches and correspondingly disclosed in the specification benefit.

In response to Appellants argument that Smith fails to disclose the rectangular patches and correspondingly disclosed in the specification benefit, Smith clearly states that the adhesive may have patterns or be applied in a continuous strip (Column 3, line 66 to Column 4, line 6). The pattern of adhesive varies as it does for the silicone patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). The shapes of the adhesive is described using the same description of the silicone patterns in the specification of the prior art of Smith as shown by the statement “Also, while continuous strips 34, 35 are desired, other patterns can be applied in the same as indicated for the silicone patterns 27, 28”. Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the patches.

**Claim 24**

Appellants argue that Smith fails to disclose the elongate transverse patches along the running axis.

In response to Appellants argument that Smith fails to disclose the elongate transverse patches along the running axis, Smith clearly states that the adhesive may have patterns or be applied in a continuous strip (Column 3, line 66 to Column 4, line 6). The pattern of adhesive varies as it does for the silicone patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). The shapes of the adhesive is described using the same description of the silicone patterns in the specification of the prior art of Smith as shown by the statement “Also, while continuous strips 34, 35 are desired, other patterns can be applied in the same as indicated for the silicone patterns 27, 28”. Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the patches.

**Claim 25**

Appellants further argue that Smith fails to disclose cooperation between the registration marks and the adhesive free zones.

In response to Appellants argument that that Smith fails to disclose cooperation between the registration marks and the adhesive free zones, the claims state that web has a series of index

marks spaced longitudinally there along to define a series of labels. The language of the claim states nothing with regard to the adhesive free zones and the index marks cooperating together as the claim does not give a specific placement of the index marks in correlation to the adhesive free zones.

**Claim 27**

Appellants argue that Smith fails to disclose the elongate patches along the running axis.

In response to Appellants argument that Smith fails to disclose the elongate patches along the running axis, Smith clearly states that the adhesive may have patterns or be applied in a continuous strip (Column 3, line 66 to Column 4, line 6). The pattern of adhesive varies as it does for the silicone patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). The shapes of the adhesive is described using the same description of the silicone patterns in the specification of the prior art of Smith as shown by the statement “Also, while continuous strips 34, 35 are desired, other patterns can be applied in the same as indicated for the silicone patterns 27, 28”. Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the patches.

**Claim 28**

Appellants argue that Smith fails to disclose a plurality of the patches in the label

In response to Appellants argument that Smith fails a plurality of the patches in the label, Smith clearly states that the adhesive may have patterns or be applied in a continuous strip (Column 3, line 66 to Column 4, line 6). The pattern of adhesive varies as it does for the silicone patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have multiple adhesive patches, since it has been held that mere duplication of the essential working parts of an article requires only routine skill in the art. MPEP 2144.04. Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the patches.

**Claim 29**

Appellants argue that Smith fails to disclose the narrow release strip.

In response to Appellants argue that Smith fails to disclose the narrow release strip, Smith clearly states that the silicone has many patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the silicone release strips.

**Claim 31**

Appellants argue that Slagsvol and Smith both fail to disclose the imperforate web.

Appellants further argue no weight has been given to the single column of noncontiguous adhesive patch.

In response to Appellants argument that Slagsvol and Smith both fail to disclose the imperforate web, Smith discloses a label roll (Column 1, lines 40 – 43) comprising web (Column 2, lines 54 – 58) that is continuous along said running axis and imperforate (Column 3, lines 6 and 7).

In response to Appellants argument that no weight has been given to the single column of noncontiguous adhesive patch, Slagsvol teaches that it is known to have adhesive patches on both edges of a substrate (Figure 5) or just on a single side (Figure 6). Therefore, it would have been obvious to one of ordinary skill in the art to place an adhesive only on one side of the substrate for the purpose of controlling the adherence of the substrate to a surface.

**Ground 4**

**Claim 26**

Appellants argue that Slagsvol is nonanalogous art relation neither to Appellants' field of endeavor or specific problems. Appellants argue that the prior art fails to disclose the full surface of the release strip in combination with the columnar adhesive patches.

In response to Appellants argument that Slagsvol is nonanalogous art relation neither to Appellants' field of endeavor or specific problems, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, a label, as defined by [www.webster.com](http://www.webster.com), is "a slip (as of paper or cloth) inscribed and affixed to something for identification or description". A label, as defined by [www.dictionary.com](http://www.dictionary.com), is "a slip of paper, cloth, or other material, marked or inscribed, for attachment to something to indicate its manufacturer, nature, ownership, destination, etc". Slagsvol becomes a label the moment a mark is made on the surface of tracing paper and the paper is stuck to the surface of an object and a mark is made on the surface of the binding strip and the paper is adhered to the surface of an object, respectively. Therefore, Slagsvol is not considered non-analogous art based on the definition of a label as they are pertinent to the particular problem with which the applicant was concerned, the placement of adhesive on the pack surface of a web.

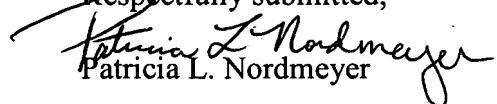
In response to Appellants argue that the prior art fails to disclose the full surface of the release strip in combination with the columnar adhesive patches, Smith clearly states that the silicone has many patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the silicone release strips.

**(11) Related Proceeding(s) Appendix**

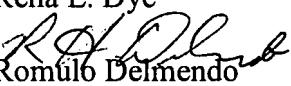
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Patricia L. Nordmeyer

Conferees:

  
Rena L. Dye  
  
Romulo Delmendo

  
RENA DYE  
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